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09/887,933	06/22/2001	Robert Patrick Hof	24615201XX00	7691

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EXAMINER

KUMAR, SHAILENDRA

ART UNIT PAPER NUMBER

1621

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 19

Application Number: 09/887,933
Filing Date: June 22, 2001
Appellant(s): HOF ET AL.

Carolyn A. Favorita
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/11/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 12-22 stand or fall together.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 12-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hijiya et al.

Instant claims are directed to a process of racemization of an enantiomer enriched Schiff base derived from primary amino acid amide by contacting the said enantiomer with a strong base in an organic solvent, wherein the strong base is reactive with water.

Hijiya et al teach a process of racemization of an enantiomer enriched Schiff base using alkaline alkoxide(base) in an organic solvent, similar to that claimed herein. See column 2, lines 5-7, column 4, lines 1-24. The difference between the reference and herein claimed process appears to be the in the absolute amount of the base and the solvent and that aide is primary in herein versus secondary and tertiary in the reference.

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use the process of Hijiya et al in the process of racemization of an enantiomer enriched Schiff base derived from the primary amide, because the prior art teaches the same analogous process using a base and an organic solvent for the amino acid amide, with the reasonable expectation of achieving a racemized product, absent evidence to the contrary. As to the amount of organic solvent and base is considered, optimization of those amount was well within the ordinary skill in the art under routine experimentation.

(11) Response to Argument

Appellants have two issues. One, whether, an organic chemistry text book excerpt relating to the background contains a new issue as alleged by the examiner in the Notification of Non Compliance mailed May 8, 2003. As pointed out by the examiner, appellants have indeed submitted a new evidence in the form of a reference, which was not presented earlier, see provisions of 37 CFR 1.192©. Had examiner presented the same background literature, appellants would have argued that a new ground of rejection has been made. Nevertheless, the same has been considered by the examiner.

As regards to the second issue, which is the main issue here, i.e obviousness issue, appellants argue that there is no teaching in Hijiya of racemization of a Schiff base of a primary amide of an amino acid, and further point out that in formula 2 or 3, which is reacted with a base, none of the nitrogen atoms are linked to the two hydrogen atoms, but rather one hydrogen atom and thus by definition are secondary amide and not primary amide. Appellants further allege that there must be some suggestion in the reference that one can modify the process to apply to the primary amide. Appellants argue that Hijiya does not suggest that a primary amide would function equivalent to secondary amide and neither the reference is directed to the claimed process. Finally, appellants urge that Hijiya does not point out to the particularly bases that are required in the instant claims, and that the motivation provided in the advisory action is insufficient.

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At the outset, the claims are directed to a process. The process of the reference is an analogous process. There is present a chiral center in the compound of the reference also. Inasmuch as there is chiral center, there is motivation for the process of racemization. Appellants have argued and admitted that Hijiya teaches a genus of amino acid amide. This genus consist of only three species, primary, secondary, and tertiary amide. Selection of three species from one genus is well within the ordinary skill in the art for the process, without undue experimentation, especially when there is a chiral center present. It is clear that the reference teaches base that is reactive with water, for example see examples 6 and 7, wherein sodium methoxide has been used as a base. Also note that the amount of base is similar in herein examples as well as in the reference.


For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,



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Art Unit 1621

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October 17, 2003

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